

REMARKS

Applicant expresses appreciation to the Examiner for consideration of the subject patent application. This amendment is in response to the Office Action (hereinafter, the "Office Action") mailed February 17, 2005. Claims 1-45 were pending with claims 1-17 being withdrawn from consideration. Claims 18-45 were rejected. Objection was raised to Claim 37.

Claims 18-45 were pending and addressed in the Office Action. Claims 18-19, 22-37 and 40-45 remain in the application. Claims 18, 23 and 37 have been amended. Claims 20, 21, 38 and 39 have been canceled. Support for the amendments to claim 18 can be found at least in previously pending claims 20 and 21. Support for the amendments to claim 37 can be found at least in previously pending claims 38 and 39. Claim 23 has been amended to correct dependency from canceled claim 20 to amended claim 18.

Drawing Objections

Objection was raised to the drawings under 37 C.F.R. § 1.83(p)(4) because reference character "24" was used to designate both the securing device and the top of the eyelet. It was indicated in the Office Action that corrected drawing sheets in compliance with 37 C.F.R. 1.121(d) were required.

Applicant respectfully submits that, while the condition pointed out in the Office Action was indeed incorrect, Applicant believes that the problem was presented by a typographical error in the specification, and not by the drawings. Accordingly, the paragraph spanning pages 5 and 6 has been amended to replace reference number "24" with the correct reference number "21."

Accordingly, Applicant submits that the objections raised to the drawings have been cured by correcting this typographical error.

Specification:

Objection was raised in the Office Action to the disclosure because the text spanning page 7, line 12 to page 8, line 6 “appear[ed] to concern the background and prior art of the invention” and that it should be moved to the section of the specification titled “BACKGROUND OF THE INVENTION.”

Applicant respectfully submits that, while the information in the pages of the specification indicated relates to the general field of scrapbooking, the information was included in the specification in order to highlight the advantages of the present invention. Applicant therefore feels that moving the information may reduce the effectiveness of the specification and, lacking an indication of a specific regulation that requires that the text be moved, Applicant respectfully requests that the information in question remain in the specification portion of the application.

Claim Objections:

Objection was raised to claim 37 because the period at the end of line 6 should be replaced with a comma. Claim 37 has been amended to correct this typographical error.

Claim Rejections:

In order to most succinctly explain why the claims presented herein are allowable, Applicant will direct the following remarks primarily to independent claims 18, 28 and 37, with the understanding that once an independent claim is allowable, all claims depending therefrom are allowable.

Claim Rejections - 35 U.S.C. § 102

Claim 18 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 67,665 (“McGill”).

Amended claim 18 includes the limitations of:

threadably attaching an interchangeable punching tip to an elongate body and forming corresponding holes in [] at least two mediums by striking an upper impact end of the elongate body, the at least two mediums being selected from the group consisting of scrapbook pages, photo album pages, photos, and decorative paper;

...

d) threadably removing the punching tip from the elongate body;

e) threadably attaching an interchangeable setting tip to the elongate body and placing the setting tip against a top of the securing device; and

f) striking the upper impact end of the elongate body attached to the setting tip to deform the top of the securing device.

Thus, amended claim 18 requires that process include the steps of threadably attaching and removing an interchangeable punching tip and setting tip to an elongate body to both form a hole in the media and to set a securing device through the hole to fasten the media.

McGill does not teach or suggest threadably attaching a punching tip or a setting tip to the McGill device.

Accordingly, amended claim 18 is not anticipated by the McGill patent.

Claim Rejections - 35 U.S.C. § 103

Independent claim 18:

Independent claim 18 was rejected under 35 U.S.C. § 103(b) as being unpatentable over U.S. Patent No. 4,649,733 (“Gilmore”) in view of McGill.

Dependent claim 24 was rejected under 35 U.S.C. § 103(b) as being unpatentable over Gilmore in view of McGill as applied to claim 18 and further in view of U.S. Patent No. 4,355,466 (“Quiring”) and U.S. Patent No. 3,327,516 (“Anderson”).

Independent claim 18 has been amended to incorporate the subject matter of claim 24. Thus, claim 18 now includes the limitations of:

A method for fastening at least two mediums of a scrapbook or photo album, comprising the steps of:

threadably attaching an interchangeable punching tip to an elongate body and forming corresponding holes in []at least two mediums by striking an upper impact end of the elongate body, the at least two mediums being selected from the group consisting of scrapbook pages, photo album pages, photos, and decorative paper;

d) threadably removing the punching tip from the elongate body;

e) threadably attaching an interchangeable setting tip to the elongate body and placing the setting tip against a top of the securing device; and

f) striking the upper impact end of the elongate body attached to the setting tip to deform the top of the securing device.

(Emphasis added)

Thus, independent claim 18 requires the limitation of threadably engaging interchangeable punching tips and setting tips to an elongate body prior to striking the elongate body to punch or set one or more mediums and/or securing devices. This aspect of the invention allows scrapbookers to easily and quickly move from punching operations to setting operations, and to quickly and easily alter tips during either punching operations or setting operations. Applicant respectfully submits that these limitations found in amended independent claim 18 are not anticipated or rendered obvious by the cited references for a number of reasons.

Firstly, the references made of record do not teach or suggest all of the limitations of the claim. Nothing in either of the Gilmore or McGill references suggests that the tips used in the Gilmore and McGill processes are interchangeable, or even removable in the ordinary course of the processes taught. As such, no reference is made to threadably or otherwise engaging tips during the Gilmore and McGill processes.

The Anderson reference similarly fails to teach threadably engaging interchangeable punching and setting tips, as the Anderson reference teaches that percussion tools are held within or on the handpiece 10 with a sophisticated magnetic mechanism that includes a magnet 17 that is slidable within a center bore 14 of the handpiece. The limitations inherent in attempting to secure a percussion tool to a handpiece with a magnetic interface are accentuated by the lengths went to by Anderson in developing an alleged working device that does so. As cited in the Office Action, page 8, “[a] threaded connect[ion] would be more stable than the Anderson magnetic connection.” Applicant agrees that a threaded connection would be more stable than the Anderson configuration, which is one of the advantages of the present invention. However,

contrary to the statements made in the Office Action, the threaded connection that was alleged to have been provided by Quiring is not, in fact, the method taught by Quiring.

Instead, the Quiring reference also fails to teach or suggest threadably engaging interchangeable punching and setting tips to an elongate body. Contrary to the assertions made in the Office Action, the Quiring reference teaches securing replacement tips to a punch body with an interference fit. As described in Quiring, column 2, lines 27 “an interference fit exists between the inside tapered surface 62 of tip 60 and tapered neck 20.” During operation, the “tool is then used in the normal punching operations, and through such operations the replacement tip is securely wedged against neck 20.” Thus, the process taught in the Quiring reference uses replacement tips that are press-fit onto neck end 20. The replacement tips of the Quiring process are not threadably engaged on the punch body.

The only threaded portions of the Quiring device is where the body 10 is threaded at 16 to receive nut 18 which is used to forceably remove the replacements tips after they become press-fit onto the neck. As described in Quiring, column 2, line 65 “[w]hen a replacement tip is to be removed a first wench is placed over flat surfaces 14, 15, and a second wrench is placed over nut 18. Nut 18 is then threadably loosened relative to shank 12 and thereby forceably removes the replacement tip from its interference fit against tapered neck 20.” Thus, Quiring does not provide a teaching of threadably engaging interchangeable tips on a punch, and accordingly the references cited fail to collectively teach or suggest all of the limitations of claim 18.

In addition, those references cited in the Office Action that include processes utilizing interchangeable tips or percussion tools, i.e., Anderson and Quiring, teach away from the claimed invention. Anderson teaches attaching interchangeable percussion tools with a sophisticated, sliding magnetic mechanism and Quiring teaches attaching interchangeable tips with a press fit or an interference fit. Thus, the accepted wisdom in the prior art is represented by press fitting or magnetized attachment methods of interchangeable tips. The present invention teaches threadably engaging interchangeable tips with a tool body, and thus proceeds contrary to the accepted wisdom in the art and represents strong evidence of nonobviousness.

Accordingly, Applicant respectfully submits that amended claim 18 is in condition for allowance.

Independent claim 28:

Independent claim 28 was rejected under 35 U.S.C. § 103(b) as being unpatentable over Gilmore in view of McGill and Schofield.

Independent claim 28 includes the limitations of:

A method for fastening at least two mediums of a scrapbook or photo album, comprising the steps of:

a) forming corresponding holes in the at least two mediums, the at least two mediums being selected from the group consisting of scrapbook pages, photo album pages, photos, and decorative paper;

b) aligning the holes in the at least two mediums;

c) disposing a securing device through the holes in the at least two mediums;

d) placing a setting tip with a raised pattern against a top of the securing device; and

e) striking an upper impact end of an elongate body attached to the setting tip to deform the top of the securing device and create a corresponding pattern of the raised pattern on the securing device.

(Emphasis added)

Thus, independent claim 28 requires the limitation of placing a setting tip with a raised pattern against a securing device and striking an upper impact end of an elongate body to create a corresponding pattern of the raised pattern on the securing device. This aspect of the invention allows scrapbookers to fasten mediums together in an aesthetically pleasing manner by setting the securing devices used to apply a particular pattern, such as flower, text, indicia, etc., to the securing devices. Applicant respectfully submits that these limitations found in independent claim 28 are not anticipated or rendered obvious by the cited references for a number of reasons.

Firstly, the references made of record do not teach or suggest all of the limitations of claim 28. Neither of the Gilmore or McGill references teaches or suggests the use of a setting tip with a raised pattern formed thereon in order to transfer the pattern to a securing device. The Schofield reference, while teaching a process by which a door seal can be compressed in a manner that allows an inspector to verify the integrity of the seal, fails to teach or suggest these limitations.

The Schofield reference, which is the only reference made of record that teaches imprinting a material with a raised pattern, utilizes a ratcheting mechanism to compress a door seal in a manner that both closes the seal and imprints about the seal a series of characters that

indicate to an inspector that the seal has been properly closed. The Schofield process thus teaches that, to properly form the pattern on the seal, the seal must be contained by a seal-press while a rotational force is applied to the device to compress the seal. Nothing in Schofield teaches or suggests that the seal can be compressed by striking the Schofield device or that the Schofield process can be carried out by impacting any aspect of the Schofield device. Accordingly, the Gilmore, McGill and Schofield references fail to teach or suggest each of the limitations of claim 28.

In addition, the references cited teach away from the subject matter of claim 18 in that they indicate that, should a securing device wish to be set, it can be done so with an impact device such as those detailed in Gilmore and McGill. However, if it is wished to set a securing device while applying a pattern thereto, the references teach that a torsional, compression process similar to that utilized by Schofield must be used. Thus, references teach that utilizing an impact setting device to apply a pattern to a securing device is not feasible.

Accordingly, Applicant respectfully submits that claim 28 is in condition for allowance.

Independent claim 37:

Independent claim 37 was rejected under 35 U.S.C. § 103(b) as being unpatentable over McGill in view of U.S. Patent No. 4,355,466 (“Quiring”).

Independent claim 37 includes the limitations of:

A method for fastening at least two mediums of a scrapbook or photo album, comprising the steps of:

- a) forming corresponding holes in the at least two mediums by:
 - i) placing a punching tip against at least one of the mediums;
 - and
 - ii) striking an upper impact end of a elongate body threadably attached to the punching tip to drive the punching tip through the at least one medium;

the at least two mediums being selected from the group consisting of scrapbook pages, photo album pages, photos, and decorative paper;

- b) aligning the holes in the at least two mediums;
- c) disposing a securing device through the holes in the at least two mediums;
- d) threadably removing the punching tip from the elongate body and threadably attaching a setting tip having a raised pattern formed thereon to the elongate body;

e) placing the setting tip against a top of the securing device; and
f) striking an upper impact end of the elongate body attached to the setting tip to deform the top of the securing device and to form a corresponding raised pattern on the securing device.

(Emphasis added)

Thus, amended claim 37 includes the limitations of both threadably engaging interchangeable punching and setting tips on an elongate body and deforming a top of a securing device to form a corresponding raised pattern on the securing device. As discussed above, none of the references cited anticipate or render obvious claims 18 and 28, which include the limitations of threadably engaging interchangeable tips and setting a securing device and forming a raised pattern on the securing device, respectively. Accordingly, claim 37, which contains both of these limitations, is not anticipated or rendered obvious by the references of record.

Accordingly, Applicant respectfully submits that independent claims 18, 28 and 37 are allowable. Further, dependent claims 19, 22-27, 29-36, and 40-45, which depend therefrom, are allowable for at least their dependency from an allowable independent claim.

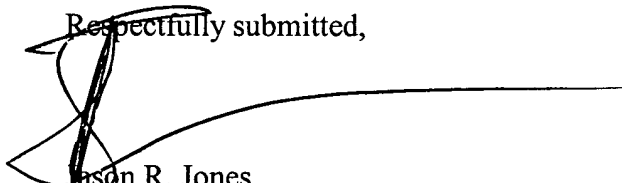
Conclusion

In light of the above, Applicant respectfully submits that pending claims 18-19, 22-37 and 40-45 are in condition for allowance. Therefore, Applicant requests that the claims be allowed and passed to issue. If any impediment to the allowance of these claims remains after entry of this Response, the Examiner is strongly encouraged to call Jason R. Jones at (801) 566-6633 so that such matters may be resolved as expeditiously as possible.

A two-month extension of time is necessary to timely file this Response. No claims have been added. Accordingly, the Commissioner is hereby authorized to charge \$225.00, and any additional fee or to credit any overpayment in connection with this Response, to Deposit Account No. 20-0100.

DATED this 18th day of June, 2005.

Respectfully submitted,



Jason R. Jones
Registration No. 51,008

THORPE NORTH & WESTERN, LLP
Customer No. 20,551
P.O. Box 1219
Sandy, Utah 84091-1219
Telephone: (801) 566-6633